

Applicant: Bhalakia et al.
Serial No.: 09/848,594

PATENT
Atty Docket No.: 10-9393

REMARKS

I. INTRODUCTION

This Amendment is filed in response to the Official Action dated March 8, 2005. In this Amendment, claims 50-58 and 80-83 are amended and new claims 84-104 are added. Claims 50-58, 80-104 are currently pending, of which claims 50 and 88 are independent claims.

II. PRIOR ART REJECTIONS

Claims 50-57 and 80-83 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,051,309 to *Kawaki et al.* Claim 58 is rejected under 35 U.S.C. § 103 as being obvious based on *Kawaki et al.* in view of U.S. Patent No. 5,631,720 to *Guglielmetti et al.* For at least the reasons stated below, these rejections are hereby traversed.

On March 28, 2005, a telephonic interview was conducted between the Examiner and the undersigned. The Examiner is thanked for granting the interview.

At the interview, the undersigned proposed an amended claim 50 for discussion. After the discussion, it was agreed that the proposed claim 50 would be formally submitted in a written response to the Official Action. This Amendment constitutes the written response.

As was first explained at the interview, amended claim 50 now recites a functional laminate disposed on an injection molded eye lens formed in a mold as opposed to a laminate for an injection molded eye lens. As a result, it is submitted that the "mere intended use" argument asserted by the Examiner in the Official Action is now rendered moot.

Next, it was pointed out that, unlike *Kawaki et al.*, the claim as amended recites that the second resinous layer is integral with a molded layer of the

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injection molded eye lens such that any thickness variation in the laminate is compensated by the molded layer of the eye lens. This recitation has support in the specification at least at page 32, lines 10-18.

Third, it was pointed out that, unlike *Kawaki et al.*, the claim as amended recites that the laminate has cut edges such that an outer dimension of the laminate snugly conforms to an outer dimension of the injection molded eye lens according to the formation of the outer dimension of the injection molded eye lens in the mold. This recitation has support in the specification at least at page 41, lines 4-10.

Finally, it was pointed out that, unlike *Kawaki et al.*, the claim as amended recites that the outer side of the first resinous layer is substantially free of optical and cosmetic defects as a result of the cut edges substantially conforming to said outer dimension of the injection molded eye lens during injection molding thereof. This recitation has support in the specification at least at page 31, line 19-24.

In sum, without conceding any of the arguments made by the Examiner in the Official Action and solely to advance the prosecution of the application, it is submitted that these additional recitations further define and describe the present invention over *Kawaki et al.*

Kawaki et al. simply fails to disclose a functional laminate disposed on an injection molded eye lens formed in a mold let alone a functional laminate on an injection molded eye lens as set forth in all of the recitations set forth in claim 50. Nor does *Guglielmetti et al.* make up for the deficiencies of *Kawaki et al.* Hence, it is submitted that neither *Kawaki et al.* alone nor *Kawaki et al.* in combination of *Guglielmetti et al.* can be properly relied upon to reject claim 50 and that claim 50 is allowable.

As to claims 51-57 and 80-83, these claims depend from claim 50 and thus these claims are allowable for at least the same reason. However, these

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claims further define and describe the invention and thus are separately patentable.

For example, claim 55 recites that the injection molded eye lens has a prescription power. Even assuming for the sake of argument that *Kawaki et al.* could somehow be construed as disclosing a functional laminate disposed on an injection molded eye lens, *Kawaki et al.* in no way discloses a functional laminate on a prescription lens, it being appreciated that the injection molding of a prescription lens is a highly precise and complex process that requires much more expertise than gleaned from the disclosure of *Kawaki et al.* alone or *Kawaki et al.* in combination with any other cited prior art.

In view of the foregoing, it is submitted that claims 50-57 and 80-83 are now in condition for allowance. An indication of such allowance is hereby requested.

III. NEW CLAIMS 84-87

New claims 84-87 are dependent upon claim 50 and are thus allowable for at least the reasons set forth above with respect to claim 50. However, these claims further define and describe the invention and are thus patentable over and above the patentability of claim 50.

New claims 88-104 are also added in this Amendment, claim 88 being a new independent claim and claims 89 - 104 being dependent therefrom. New independent claim 88 recites in essential respects the same concepts as the recitations discussed above with respect to claim 50 although it is acknowledged that the recitations in claim 88 are not worded identically to those recited in claim 50. Nonetheless, it is submitted that the same arguments set forth above apply in essential respects to new claim 88 and for at least this reason, it is submitted that these new claims are also patentable.

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CONCLUSION

In summary, it is submitted that all currently pending claims 50-57 and 80-104 are now in condition for allowance. An indication of the same is therefore requested. If any issues remain that the Examiner finds more efficiently addressed through telephonic communication, it is cordially urged that the undersigned be contacted at the number listed below.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,

Dated: April 6, 2005



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